

**Notice of Allowability**

Application N .

10/727,398

Examiner

Hector M Reyes

Applicant(s)

TANAKA ET AL.

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the Initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to \_\_\_\_\_.
2. ☒ The allowed claim(s) is/are 19 and 21-25, renumbered as 1-6.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☒ Certified copies of the priority documents have been received in Application No. 10/320,325.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |  |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                    |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material          | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance   |
|   | 9. <input type="checkbox"/> Other _____.   |

## DETAILED ACTION

### Status of The Claims

Claim 20 has been canceled. Claim 19 has been amended. Claims 19 and 21-25 are under Examination. The said claims are being re-numbered by the Examiner as claims 1-6.

### ALLOWANCE

The following is an examiner's statement of reasons for allowance: In claims 1-6, as renumbered Applicants claim a process for preparing racemic 3-hydroxy-3-(2-phenylethyl)hexanoic acid C<sub>1-6</sub> alkyl ester derivatives by reacting magnesium, a chloroacetic acid C<sub>1-6</sub> alkyl ester derivative and 1-phenyl-3-hexanone.

No prior art disclosing or suggesting the instant invention was found. The closest art was found in:

- Sorger et al, US patent 6605716 B2
- Moriwake, J. Org. Chem., 31, 983-985, (1966).

Sorger discloses a method for the preparation of a series of compounds via the Reformatsky reaction. Among the compounds prepared by Sorter is methyl 3-hydroxy-3-(2-phenylethyl)caproate, see col. 9, Example 5. The said preparation comprises:

- Preparing the corresponding zinc enolate of ethyl acetate with trimethylchlorosilane
- Reacting the said enolate with 1-phenylhexan-3-one.

Sorger also teaches that the said ketone is prepared by base-catalyzed aldol condensation of benzaldehyde and penta-2-one followed by hydrogenation. On the other hand, Moriwake teaches that the Reformatsky reaction can be carried out conveniently by magnesium with

Art Unit: 1625

improved yields, when using the corresponding **bromo magnesium enolates of tert-butyl esters**. Moriwake teaches away from the use of non-bromo tert-butyl esters derivatives as reagents in a condensation with a secondary carbonyl derivative since self-condensation takes place producing the corresponding ketoester.

The cited references do not teach or suggest the use of chloro magnesium ester enolates as reactants in a condensation reaction with a non-ester carbonyl reactant, as required in the instant process.

### **CONCLUSION**

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee.

Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

All post-Allowance Correspondence concerning this Application must be mailed to:

**BOX ISSUE FEE  
COMMISSIONER FOR PATENTS  
WASHINGTON, DC 20231**

Or you can fax them to the Office of Patent Publications at 703-308-5083, in order to expedite the handling of such correspondence as amendments under 37 CFR 1.312; information disclosure statements, and formal drawings. Sending Post-Allowance papers to Technology Center 1600 will only cause delays in matching papers with the case.

Application/Control Number: 10/727,398

Page 4

Art Unit: 1625

For information concerning status of correspondence sent after receipt of the Notice of

Allowance, please contact the Correspondence Branch at (703) 305-8027.

Héctor M. Reyes, PhD, Esq.

USPTO Reg. # 54, 846

AU 1625

January 7, 2005

*H. Reyes*  
1/10/05